IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	Joseph G. GATTO
SERIAL NO.:	09/775,599
ATTORNEY DOCKET NO:	089070-0311371 (*23449-016*)
FILING DATE:	February 5, 2001
ART UNIT :	3624
EXAMINER	NARAYANSWAMY SUBRAMANIAN
FOR:	SECURITY ANALYST ESTIMATES PERFORMANCE VIEWING SYSTEM AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Final Office Action mailed **October 11, 2005** (hereinafter "Final Action"), Applicant requests a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

Review is requested for the reasons set forth in the **Remarks** beginning on page 2 of this paper.

A total of 5 pages are provided.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 033975 (**Ref. No. 089070-0311371**).

REMARKS

Claims 1, 3-38, and 40-54 are pending in this application. Review is requested for: (1) the rejection of claims 1, 3-38, and 40-54 under 35 U.S.C. §101; and (2) the rejection of claims 1, 3-23, 38, and 51 under 35 U.S.C. §103(a)[1]. Claims 24-37, 40-50, and 52-54 are indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *See* Final Action, pg. 5, ¶8. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. §101

Review is requested for the rejection of claims 1, 3-38, and 40-54 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner alleges that the method claims as presented do not claim a technological basis in the body of the claims. *See* Final Action, pg. 2, ¶3. This rejection is improper for at least the reason that the Examiner is improperly reading limitations into 35 U.S.C. §101 on the subject matter that may be patented. The Board of Patent Appeals and Interferences has held that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." *Ex Parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). As such, the Examiner's focus on whether the claim involves a technological basis is not relevant. Accordingly, the rejection of claims 1, 3-38, and 40-54 under 35 U.S.C. §101 is legally improper and should be withdrawn.

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[1] Applicant notes the rejection of claims 1, 38, and 51 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 44 and 48 of U.S. Patent Application No. 09/524,253. *See* Final Action, pg. 3, ¶5. Although Applicant disagrees with the double-patenting rejection set forth by the Examiner, Applicant does not request review of this rejection. Rather, Applicant will consider filing a terminal disclaimer upon the indication of allowed claims. Applicant notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District,* 946 F.2d 870, 20 USPQ2d (BNA) 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

REJECTIONS UNDER 35 U.S.C. §103

Review is requested for the rejection of claims 1, 3-23, 38, and 51 under 35 U.S.C. §103(a) over U.S. Patent No. 6,073,115 to Marshall in view of U.S. Patent No. 5,608,620 to Lundgren. *See* Final Action, pg. 5, ¶7. The Examiner has maintained the rejections previously set forth in the First Office Action mailed March 25, 2005 (hereinafter "First Office Action") beginning at pg. 5, ¶9. The rejection of claims 1, 3-23, 38, and 51 should be withdrawn for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Independent claims 1, 38, and 51.

Independent **claim 1** recites, *inter alia*, the features of:

> ...displaying simultaneously, on an analyst by analyst basis, for selected analysts:
> i) an indication of historical accuracy for an analyst based on selected criteria; and
> ii) the analyst's estimate for a future event.

Independent **claim 38** recites, *inter alia*, the features of:

> ...displaying simultaneously, on an analyst by analyst basis, for selected analysts:
> i) an indication of historical performance for an analyst based on selected criteria; and
> ii) the analyst's recommendation for a future event.

Independent **claim 51** recites, *inter alia*, the features of:

> ...displaying simultaneously, on an analyst by analyst basis, for selected analysts:
> i) an indication of historical accuracy for an analyst for one or more securities;
> ii) current estimate of a future event associated with the analyst for the one or more securities; and
> iii) model information relating to the analyst.

Independent claims 1, 38, and 51 recite that an indication of historical accuracy (or performance) for an analyst is displayed simultaneously with the analyst's estimate (or

recommendation) for a future event. Neither Marshall nor Lundgren, either alone or in combination, appear to disclose, teach, or suggest *at least* these features.

In the First Office Action, at pgs. 5-6, the Examiner apparently relies on Marshall for the teaching of displaying information related to financial data in a format selected by a user. The Examiner concedes that Marshall does not explicitly teach the remaining features of independent claims 1, 38, and 51. The Examiner relies on Lundgren for the missing features, however, alleging that the "*combination of the disclosures taken as a whole suggests that users would have benefited from being able to view data about analysts' forecasts in a format they are comfortable with and helped them in their decision making.*" This is legally improper. Marshall is directed to a virtual reality generator for displaying abstract information, while Lundgren appears to be concerned with eliciting unbiased forecasts (and motivating forecasters) by relating a forecaster's pay to the forecaster's contribution to a collective forecast. Lundgren does not appear to be concerned with the display of financial information. Moreover, the Examiner's recited motivation merely states what "benefit" the combination of the disclosures may provide. In other words, the Examiner has focused on the "result" of the combination of Marshall and Lundgren, but has not provided a legally proper teaching, suggestion, or motivation to combine the two references. For *at least* each of the foregoing reasons, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a).

Assuming arguendo that Marshall and Lundgren could be combined, the combined references fail to disclose, teach, or suggest all of the features of claims 1, 38, and 51. In particular, Lundgren fails to cure the deficiencies of Marshall conceded by the Examiner.

Neither the passages relied upon by the Examiner in Marshall (*e.g.*, Abstract; col. 3, lines 41-48; & claim 1) nor the passages relied upon by the Examiner in Lundgren (*e.g.*, Abstract; FIG. 1; col. 1, lines 21-50; col. 6, lines 43-45; col. 6, line 53-col. 7, line 18; and claims 1, 6, 8-11), either alone or in combination, disclose *at least* the features of displaying simultaneously, on an analyst by analyst basis, for selected analysts: an indication of historical accuracy (or performance) for an analyst and the analyst's estimate (or recommendation) for a future event. Additionally, with regard to independent claim 51, neither Marshall nor Lundgren, either alone or

in combination, appear to disclose, teach, or suggest the feature of further displaying model information relating to the analyst.

For *at least* each of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, independent claims 1, 38, and 51 are patentable over Marshall in view of Lundgren.

B. Dependent claims 3-23.

In the 06/27/05 Response to First Office Action, Applicant traversed the Examiner's unsupported contention (*see* First Office Action, pg. 7) that the features of claims 3-23 were old and well known in the art. In the Final Action (at pg. 6), the Examiner responds - not by providing evidentiary support - but by merely reciting: "*[a]pplicant's arguments with respect to other claims have been considered but are not persuasive.*" The Examiner has failed to provide any documentary evidence in support of the allegation that the features of claims 3-23 were old and well known, and has thus failed to establish a *prima facie* case of obviousness. For *at least* this reason, the rejection of claims 3-23 is improper and should be withdrawn.

Respectfully submitted,

By: _____ Date: January 11, 2006
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